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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,144	08/05/2005	Hirotsugu Kinoshita	07481.0036-00000	9210
22852	7590	04/02/2008		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER GOLOBY, JAMES C	
			ART UNIT	PAPER NUMBER
			1797	
			MAIL DATE	DELIVERY MODE
			04/02/2008 PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/522,144

**Applicant(s)**

KINOSHITA ET AL.

**Examiner**

James Goloboy

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/02)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Applicant's amendments and arguments filed 12/6/07 have been considered. The rejection of claims 1-3 as anticipated by Takeuchi has been maintained. The rejection of claims 1, 3, and 6 over Kinoshita has also been maintained, and further explanation necessitated by applicant's amendment has been set forth below. A new ground of rejection for claims 1 and 4-6 necessitated by applicant's amendment has also been set forth below.

***Claim Rejections - 35 USC § 102***

2. Claims 1, 3, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Kinoshita (U.S. Pat. No. 5,462,683, "Kinoshita '683").

Comparative example 6 of Kinoshita '683 (Table 3, column 33) discloses a grease composition consisting of a lubricating base oil, 7.5% by weight of a lithium soap thickener, 1.0% by weight of a tributylphosphite, an antioxidant, and polysulfides. From column 25 line 63 through column 26 line 20 Kinoshita '683 discloses that the polysulfides are an extreme pressure agent, an additive recited in claim 1. The example of Kinoshita therefore meets the limitations of claims 1, 3, and 6.

3. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Takeuchi (U.S. Pat. No. 5,516,439).

This rejection is adequately set forth in paragraph 6 of the office action mailed 8/8/07, which is incorporated here by reference.

4. Claims 1 and 4-6 are rejected under 35 U.S.C. 102(b) as being Kinoshita by (U.S. Pat. No. 5,043,085, "Kinoshita '085").

In Table 1 (columns 7-8), examples 2 and 7-8, Kinoshita '085 discloses grease compositions consisting of a lubricating base oil, a thickener, and diphenyl hydrogen phosphite. In columns 6-7 Kinoshita '085 provides the preparations of the thickeners, which meet the limitations of claims 4-5, and in column 3 lines 3-30 discloses that the urea of claim 5 is a particularly preferred thickener. In column 5 lines 43-51 Kinoshita '085 discloses that the concentration of thickener falls within the range recited in claim 1. The diphenyl hydrogen phosphite meets the limitations of formula (1) of claims 1 and 6, where the X atoms are oxygen, two R groups are phenyl, and one R group is hydrogen. The composition of Kinoshita '085 therefore meets the limitations of claims 1 and 4-6.

In column 6 lines 16-28, Kinoshita '085 discloses that the grease can optionally contain further additives such as an antioxidant, an extreme pressure agent, an oiliness agent, and a viscosity index improver, as recited in claim 1.

### ***Response to Arguments***

5. Applicant's arguments filed 12/6/07 have been fully considered but they are not persuasive.

Applicant argues that the amendment to claim 1 distinguishes the claim over the Takeuchi reference because "the grease composition of the present application as

claimed, does not include a metal salt selected from the group consisting of metal salts of oxidized waxes, metal salts of petroleum sulfonates and metal salts of alkyl aromatic sulfonates as required by Takeuchi". However, Takeuchi teaches in column 4 lines 14-28 that these metal salts are useful as rust inhibitors, which are a permitted component of the composition of amended claim 1. While Takeuchi discloses that the metal salts also have wear-inhibiting properties in the grease of Takeuchi, there is no indication that the metal salts do not also retain their rust-inhibiting properties. The metal salt-containing greases of Takeuchi therefore fall within the scope of amended claim 1.

Applicant argues that Comparative Example 6 of Kinoshita '683 does not meet the limitations of the amended claims, because it includes polysulfides. However, applicants themselves acknowledge that the polysulfides are an extreme pressure agent, which is a permitted component of the composition of amended claim 1. Therefore, the amended claim does not overcome Comparative Example 6 of Kinoshita '683.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is (571)272-2476. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JCG

/Glenn A Caldarola/  
Acting SPE of Art Unit 1797

